

Atty's Docket: Bayer: 10,10197.2

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

REMARKS

Claims 1-27 were pending in the application. New claim 28 has been added.

Claim 16 has been amended by adding a limitation that the analgesics in elements A and B are distinct from each other. This is essentially the same distinction recited in claim 1.

Support for new claim 28 may be found on page 3, lines 11-15.

No amendments introduce new matter.

Response to Examiner's Comments**1. Claims 16-27 are rejected under § 112, 2nd paragraph**

Examiner rejected claim 16 because the "element B" is alleged to be indefinite as not being defined by the claim. It is further alleged that elements A and B in claims 21-23 are not defined, thus rendering claims 21-23 indefinite.

Claim 16 has been amended by adding a limitation that the analgesics in elements A and B are distinct from each other. This is similar to the distinction between elements A and B that is recited in claim 1.

The MPEP's guidelines indicate that claim language is to be considered in view of the following:

(A) The content of the particular application disclosure;

Atty's Docket: Bayer: 10,10197.2

- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

MPEP § 2173.02.

The invention is disclosed and claimed as a combination comprising distinct compounds having analgesic properties; e.g., spec, p.3. The analgesics maybe differentially compartmentalized into, e.g., element A and element B, in accordance with the analgesics' distinctive properties.

Person's of ordinary skill would readily appreciate the scope of embodiments encompassed by the claims. This is especially true in view of the background given in the specification.

Applicants respectfully request the Examiner's help in identifying the specific source(s) of any indefiniteness. Absent such guidance, it is respectfully suggested that the claims are not indefinite as they fully comply with MPEP examination guidelines as stated above.

In view of these comments and the MPEP guidelines on indefiniteness, Applicants respectfully request withdrawal of the rejection.

2. Anticipated by US '884 to Desai

Examiner alleges that Desai anticipates the claimed subject matter.

Applicants point out that the claimed composition specifies that elements A and B comprise two different analgesic compounds. Desai's combination is based only on a single analgesic – naproxen.

Thus, Desai does not teach or suggest at least two claim limitations: (a) combining distinct analgesic compounds, and (b) combining a locally acting analgesic and a systemically acting analgesic. Desai merely discloses a composition effecting the differential systemic release of naproxen into the blood. See Abstract; Fig. 5.

Atty's Docket: Bayer 10,10197.2

Examiner is respectfully reminded that he has already applied a virtually identical reference to Desai in this application; that would be US '320 to Bourke. Bourke also discloses a preparation of differentially released naproxen. The rejection based on Bourke was withdrawn in response to the preliminary amendment of 20 February 2001.

It is clear that Desai cannot reasonably be held as anticipatory prior art. Nor is Desai proper prior art under § 103(a) as it nowhere suggests modifying the composition to approximate that in the claims.

The instant application was filed over four years ago. Yet in that time, no prior art has been offered that teaches or suggests the claimed subject matter. The absence of proper prior art is further evidenced by the Examiner reasserting a virtually identical reference that had already been overcome years ago.

It is respectfully suggested that the claims are in allowable condition and such allowance should be granted.

Should Examiner believe that there still exist issues precluding a granting of allowance, it is respectfully requested that such issues be specifically and clearly articulated to allow a comparably specific response. MPEP § 706.

Respectfully Submitted,

Norris, McLaughlin & Marcus
220 East 42nd Street
New York, NY 10017
Telephone (212) 808-0700
Facsimile (212) 808-0844


Theodore Gottlieb, PhD
Reg. Nr. 42,597